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RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE
GROUP 1774
PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q61200

Hiroshi OGAWA, *et al.*

Appln. No.: 09/810,230

Group Art Unit: 1774

Confirmation No.: 6907

Examiner: Camie S. THOMPSON

Filed: March 19, 2001

For: RADIATION IMAGE CONVERSION PANEL AND MANUFACTURING METHOD
THEREFOR

RESPONSE UNDER 37 C.F.R. § 1.116

MAIL STOP AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Please consider the remarks below in reply to the Office Action mailed March 3, 2004.

Claims 1-10 are all the claims pending in the application.

The Office Action Summary page attached to the Office Action mailed September 10, 2003, indicates that a copy of the Form PTO/SB/08 A & B (modified) included with the Information Disclosure Statement (IDS) filed on March 19, 2001, was attached to the Office Action. Applicants, however, did not actually receive a copy of the Form SB/08 with the Office Action.

Applicants kindly request a new copy of the Form SB/08 to be included with the next communication to Applicants.

In response to the Examiner's remarks at Section No. 1, page 2, of the final Action, Applicants respectfully request to have withdrawn method Claims 7 and 8 rejoined in the event

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that elected product Claim 1 is found allowable. Where an applicant elects claims directed to a product, and a product claim is subsequently found allowable, withdrawn method claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined. MPEP §821.04.

Applicants note with appreciation the Examiner's indication at Section Nos. 2-3, page 2, of the final Action, of the withdrawal of the objection to the abstract and the §103 rejection based on U.S. Patent No. 5,905,014 to Van de Bergh in view of U.S. Patent No. 6,262,424 to Yanagita, *et al.* ("Yanagita").

Accordingly, the final Action contains a single rejection, i.e., the §102(b) rejection presented at Section Nos. 5-6, pages 3-4, of the final Action. Specifically, Claims 1-6 and 9-10 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,523,558 to Bringley, *et al.* ("Bringley").

Applicants respectfully traverse.

The claimed aryl carboxylic acid or alicyclic carboxylic acid does not encompass the stabilizing compounds disclosed in Bringley.

At Section No. 6 of the final Action, the Examiner asserts the following (emphasis in the original):

Applicant claims **an** aryl carboxylic acid. The instant claims do not disclose a specific aryl carboxylic acid.

Applicants respectfully disagree.

The claims recite a specific aryl carboxylic acid or alicyclic carboxylic acid. In particular, the aryl carboxylic acid or alicyclic carboxylic acid recited in Claim 1 is an aryl carboxylic acid or alicyclic carboxylic acid having the formula $R-R^1-COOX$ or $R-COOX$.

In the formula $R-R^1-COOX$ or $R-COOX$, R must be (1) an aryl group; (2) an aryl group, replaced with an alkyl group whose number of carbons is 1 to 5, a hydroxyl group, a carboxylic acid group, or a halogen group; (3) a hydroaryl group; or (4) a hydroaryl group (alicyclic group),

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replaced with an alkyl group whose number of carbons is 1 to 5, a hydroxyl group, or a halogen group.

In the formula $R-R^1-COOX$ or $R-COOX$, X represents a hydrogen atom, alkaline metal, or $-N^+(R^2)_4$ (where R^2 represents an alkyl group whose number of carbons is 2 or less).

In the formula $R-R^1-COOX$, R^1 is a hydrocarbon radical whose number of carbons is 1 to 12.

Accordingly, Claim 1 does not include within its scope any and all aryl carboxylic acids or alicyclic carboxylic acids. Claim 1 is specifically directed to radiation image conversion panels comprising an aryl carboxylic acid or alicyclic carboxylic acid having the formula $R-R^1-COOX$ or $R-COOX$, wherein R, R^1 , and X are particularly defined (see above and Claim 1).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The metal hydride stabilizing compounds identified by the Examiner, which are disclosed at column 4, lines 15-68, of Bringley, and are represented by the formula $D_x[MH_aR_b]_y$, do not anticipate the specific aryl carboxylic acid or alicyclic carboxylic acid recited in Claim 1 because they do not fall within the scope of the specific aryl carboxylic acid or alicyclic carboxylic acid recited in Claim 1. It is not enough that Bringley discloses that the R group in the formula $D_x[MH_aR_b]_y$ may be an aryl group (column 4, line 39) or that Bringley discloses $\text{---}\overset{\text{O}}{\parallel}\text{C}\text{---O---}$ as a linking group between 2 to 3 linked rings of the R group in formula $D_x[MH_aR_b]_y$. Bringley must disclose an aryl carboxylic acid or alicyclic carboxylic acid having the formula $R-R^1-COOX$ or $R-COOX$, wherein R, R^1 , and X are particularly defined as in present Claim 1, and Bringley fails to do so.

For example, even though Bringley discloses an aryl group as an example of the R group in its metal hydride stabilizing compound, Bringley's disclosure of metal hydride stabilizing

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compounds is still limited to those compounds having the formula $D_x[MH_aR_b]_y$, wherein D is an inorganic or organic cation, M is aluminum or boron, and R is as defined at column 4. Applicants have been unable to identify a compound which meets the limitations of having the formula $D_x[MH_aR_b]_y$, wherein D is an inorganic or organic cation, M is aluminum or boron, and R is as defined at column 4, and also meets the limitations of the presently claimed aryl carboxylic acid or alicyclic carboxylic acid having the formula $R-R^1-COOX$ or $R-COOX$, wherein R, R^1 , and X are particularly defined (see above and Claim 1).

Furthermore, Bringley's disclosure of $\text{---}\overset{\text{O}}{\parallel}{\text{C}}\text{---O---}$ (column 4, line 50) is limited to compounds wherein $\text{---}\overset{\text{O}}{\parallel}{\text{C}}\text{---O---}$ is a linking group between 2 to 3 linked rings. Accordingly, Bringley's disclosure is necessarily limited to those compounds wherein the $\text{---}\overset{\text{O}}{\parallel}{\text{C}}\text{---O---}$ group is bounded by at least one ring on each of its sides. On the other hand, the $-COO$ moiety of the presently claimed aryl carboxylic acid or alicyclic carboxylic acid is a $-COOX$ moiety, wherein X represents a hydrogen atom, alkaline metal, or $-N^+(R^2)_4$ (where R^2 represents an alkyl group whose number of carbons is 2 or less). Accordingly, Bringley, which is limited to compounds wherein $\text{---}\overset{\text{O}}{\parallel}{\text{C}}\text{---O---}$ is a linking group between 2 to 3 linked rings, does not disclose the presently claimed aryl carboxylic acid or alicyclic carboxylic acid having the formula $R-R^1-COOX$ or $R-COOX$, wherein R, R^1 , and X are particularly defined (see above and Claim 1).

In the event that the Examiner disagrees with the foregoing, Applicants respectfully request that the Examiner identify a particular compound which has the formula $D_x[MH_aR_b]_y$ and also meets the limitations of the presently claimed aryl carboxylic acid or alicyclic carboxylic acid.

Finally, Applicants would like to point out the following as further evidence of the patentability of the claimed invention.

In Bringley, the metal hydride compound is used for preventing yellowing. Applicants refer to column 3, Summary of the Invention). Examples 1 to 3 at Bringley's Table 1 show

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higher PSL responses than the PSL response of the comparative example because the metal hydride stabilizing compounds enhance stability against yellowing of the panel.

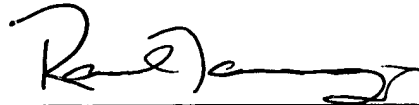
In contrast, the present invention has been made based on the finding that the imaging plate having high PSL response and improved running durability can be obtained by improving the dispersion stability of the phosphor material to have high phosphor fill ratio. Applicants refer the Examiner's attention to the section from page 28, line 23, to page 29, line 25, and Table 1 of the present specification. The high PSL response of the invention is obtained because of the high phosphor fill ratio, not because of preventing yellowing. Therefore, the present invention would not have been anticipated by Bringley.

For the foregoing reasons, Applicants respectfully request that the Examiner reconsider and withdraw the §102(b) rejection of Claims 1-6 and 9-10.

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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23373

CUSTOMER NUMBER

Date: August 3, 2004